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EXAMINER

ART UNIT PAPER NUMBER

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Please find below and/or attached an Office communication concerning this application or proceeding.

16

**Notification of Non-Compliant Appeal Brief
(37 CFR 41.37)**

Application No.

10/007,613

Applicant(s)

H. SHIH, JASON C.

Examiner

Zachariah Lucas

Art Unit

1648

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 25 August 2005 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer.

EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.

1. ☒ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☒ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☒ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☐ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☐ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner **and relied upon by appellant in the appeal**, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☒ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☒ Other (including any explanation in support of the above items):


See Continuation Sheet.

Note- attached pages of Federal
REgister, Volume 69, No. 155, pages
49962-63, and 49978.

Continuation of 10. Other (including any explanation in support of the above items): The Brief does not comprise the items required under 37 CFR 41.37(c) under the appropriate headings as set forth in the rule. In particular, the Brief contains the separate sections of Issues and Grouping of the Claims instead of the required section (37 CFR 41.37(c)(1)(vi)) of "Grounds of rejection to be reviewed on appeal." Further, the Appeal Brief identifies issues, not rejections, to be determined. The new rules require the identifies of the rejections on appeal. See, 69 Federal Register, page 49962, right column (item [8]).

The Brief does not provide a concise explanation of only the independent claims, and those dependent claims that are argued separately as required by 37 CFR 41.37(c)(1)(v).

With respect to item 9 above, it is noted that in response to comments on the revised rules regarding appeals, the Office indicated that if there are no related decisions, the Appendix regarding such must still be included, but would indicate that there are no such decisions. See, 69 Federal Register, page 49978, Comment 60 (right column).


JAMES HOUSEL 9/6/05
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600



Federal Register

Thursday,
August 12, 2004

Part II

Department of Commerce

Patent and Control Office

37 CFR Parts 1, 5, 10, 11, and 41
Rules of Practice Before the Board of
Patent Appeals and Interferences; Final
Rule

application for a patent, an application for reissue of a patent, or an ex parte reexamination proceeding to the Board.

Section 41.30 sets forth definitions for Board proceedings under subpart B of part 41. The preamble to § 41.30 is based on a similar provision in the preamble of former Rule 601. The term "proceeding" sets forth a generic term for a national application for a patent, an application for reissue of a patent, and an ex parte reexamination proceeding. The term "applicant" sets forth a generic term for either the applicant in a national application for a patent or the applicant in an application for reissue of a patent. The term "owner" sets forth a shorthand reference to the owner of the patent undergoing ex parte reexamination under Rule 510.

Section 41.31 is added to generally incorporate the requirements of former Rule 191(a)–(d). Paragraph (a) is subdivided into three parts to improve readability. Paragraph (d) is amended to refer only to the time periods referred to in paragraphs (a)(1)–(a)(3) of this section, while the current extension of time requirements for Rules 192, 193, 194, 196 and 197, formerly provided in Rule 191(e), is relocated to §§ 41.37, 41.41, 41.47, 41.50 and 41.52.

Section 41.33 is added to replace the requirements of former Rules 116 and 195. Paragraph (a) provides that amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1)–(a)(3) and prior to the date a brief is filed pursuant to § 41.37 may be admitted as provided in § 1.116. Thus, amendments after final but prior to appeal and amendments filed after appeal but prior to the date the brief is filed will be treated under the same standard (i.e., § 1.116). Paragraph (b) provides that amendments filed on or after the date of filing a brief pursuant to § 41.37 may be admitted: (1) to cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, or (2) to rewrite dependent claims into independent form. A dependent claim is rewritten into independent form by including all of the limitations of the base claim and any intervening claims. Thus, no limitation of a dependent claim can be excluded in rewriting that claim into independent form. Paragraph (c) provides that all other amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1)–(a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i), 41.50(b)(1) and 41.50(c). Paragraph (d)(1) provides that affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1)–(a)(3) and prior to the date

of filing a brief pursuant to § 41.37 may be admitted if the examiner determines that the affidavits or other evidence overcomes all rejections under appeal and that there is a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. Paragraph (d)(2) provides that all other affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1)–(a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1). Paragraph (d) replaces the former practice of permitting such evidence based on a showing of good and sufficient reasons why such evidence was not earlier presented set forth in former Rule 195. The Office believes that prosecution should occur before the examiner prior to an appeal being filed, not after the case has been appealed pursuant to § 41.31(a)(1)–(a)(3).

Section 41.35 is added to generally incorporate the requirements of former Rule 191(e). In addition, this section makes clear that jurisdiction over an application may be relinquished by the Board and the application returned to the examining operation to permit processing to be completed by the examining operation before the Board takes up the appeal for decision. This is consistent with the present practice of returning an appealed application to the examining operation where some matter requiring attention has been identified prior to assignment of the appeal number and docketing of the appeal. In addition, the Board is permitted to take other appropriate action to complete the file.

Section 41.37 is added to generally incorporate the requirements of former Rule 192. In addition, the following changes have been made:

(1) The title of the section has been changed from "Appellant's brief" to "Appeal brief".

(2) In paragraph (a), one copy of the brief is required rather than three copies consistent with the Office's move to an electronic file wrapper.

(3) In paragraph (a), the brief is required to be filed within two months from the date of the notice of appeal under § 41.31 even if the time allowed for reply to the action from which the appeal was taken is later, which overall simplifies docketing of the due date.

(4) In paragraph (c)(1)(i), a statement is required in the brief identifying by name the real party in interest even if the party named in the caption of the brief is the real party in interest. This provides appellant the necessary mechanism for complying with § 41.8(a) in an appeal to the Board.

(5) In paragraph (c)(1)(ii), identification is required of all other prior and pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal, as well as to set forth a mechanism for complying with § 41.8(b) in an appeal to the Board.

(6) In paragraph (c)(1)(iii), both a statement of the status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of those claims that are being appealed is required.

(7) In paragraph (c)(1)(v), a concise explanation of the invention is required for each of the independent claims involved in the appeal, which explanation shall refer to the specification by page and line number, and to the drawings, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. The former requirement of Rule 192(c)(5) to set forth a concise explanation of the invention defined in the claims involved in the appeal by reference to the specification by page and line number, and to the drawings, if any, by reference characters was not being followed in a great number of briefs before the Board.

(8) In paragraph (c)(1)(vi), a concise statement listing each ground of rejection presented for review is required rather than issues for review. An example of a concise statement is "Claims 1 to 10 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. X."

(9) The grouping of claims requirement set forth in former Rule 192(c)(7) is removed. The general purpose served by former Rule 192(c)(7) is addressed in § 41.37(c)(1)(viii). The existing grouping of claims requirement has led to many problems such as (i) Grouping of claims across multiple rejections (e.g., claims 1–9 rejected under 35 U.S.C. 102 over A while claims 10–15 are rejected under 35 U.S.C. 103 over A and the appellant

states that claims 1–15 are grouped together); (ii) Claims being grouped together but argued separately (e.g., claims 1–9 rejected under 35 U.S.C. § 102 over A, the appellant groups claims 1–9 together but then argues the patentability of claims 1 and 5 separately); and (iii) examiners disagreeing with the appellant's grouping of claims.

(10) In paragraph (c)(1)(vii), any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown (requirement found in former Rule 192(a)), and a separate heading is required for each ground of rejection in place of the previous grouping of claims section of the brief. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When an appellant argues as a group multiple claims subject to the same ground of rejection, the Board may select a single claim from that group of claims and treat its disposition of a ground of rejection of that claim as applying to the disposition of that ground of rejection of all claims in the group of claims.

Notwithstanding any other provision of this paragraph, an appellant's failure to argue separately claims that the appellant has grouped together constitutes a waiver of any argument that the Board must consider the patentability of any grouped claim separately. See *In re McDaniel*, 293 F.3d 1379, 1384, 63 USPQ2d 1462, 1465–66 (Fed. Cir. 2002) (interpreting former Rule 192(c)(7) to require separate treatment of separately rejected claims). Any claim argued separately should be placed under a subheading identifying the claim by number and claims argued as a group should be placed under a subheading identifying the claims by number. For example, if Claims 1 to 5 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. Y and appellant is only going to argue the limitations of independent claim 1, and thereby group dependent claims 2 to 5 to stand or fall with independent claim 1, then one possible heading as required by this subsection could be *Rejection under 35 U.S.C. 102(b) over U.S. Patent No. Y* and the optional subheading would be Claims 1 to 5. As another example, where claims 1 to 3 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. Z and the appellant wishes to argue separately the patentability of each claim, a possible heading as required by this subsection could be *Rejection under 35 U.S.C. 102(b) over U.S. Patent No. Z*, and the

optional subheadings would be *Claim 1*, *Claim 2*, and *Claim 3*. Under each subheading the appellant would present the argument for patentability of that claim.

(11) Paragraph (c)(1)(vii) states that “Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable”, a statement in slightly different form appeared in former Rule 192(c)(7).

(12) Paragraph (c)(1)(vii) eliminates subparagraphs (i) through (v) of former Rule 192(c)(8) which related to the manner in which arguments were to be made. Although they provided useful advice as to what an effective argument ought to include, these provisions have often been ignored by appellants and, for the most part, have not been enforced as set forth in paragraph (d) of that rule.

(13) Paragraph (c)(1)(ix) is added to require appellant to include an evidence appendix of any evidence relied upon by appellant in the appeal with a statement setting forth where that evidence was entered in the record by the examiner so that the Board will be able to easily reference such evidence during consideration of the appeal.

(14) Paragraph (c)(1)(x) is added to require appellant to include a related proceedings appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section so that the Board can take into consideration such decisions.

(15) Paragraph (c)(2) is added to exclude any new or non-admitted amendment, affidavit or other evidence from being included in the brief.

(16) Paragraph (d) is added to provide that appellants will be notified of reasons for non-compliance and given a period of time to file an amended brief.

(17) Paragraph (e) is added to provide notice that the periods set forth in this section are extendable under the provisions of Rule 136 for patent applications and Rule 550(c) for ex parte reexamination proceedings. This provision appeared in former Rule 191(d).

Section 41.39 is added to generally incorporate requirements found in former Rule 193(a).

Section 41.39(a)(2) is added to permit a new ground of rejection to be included in an examiner's answer eliminating the former prohibition of new grounds of rejection in examiner's answers. Many appellants are making new arguments for the first time in their appeal brief (apparently stimulated by a former change to the appeal process that inserted the prohibition on new grounds

of rejection in the examiner's answer). Because the current appeal rules only allow the examiner to make a new ground by reopening prosecution, some examiners have allowed cases to go forward to the Board without addressing the new arguments. Thus, the revision would improve the quality of examiner's answers and reduce pendency by providing for the inclusion of the new ground of rejection in an examiner's answer without having to reopen prosecution. By permitting examiners to include a new ground of rejection in an examiner's answer, newly presented arguments can now be addressed by a new ground of rejection in the examiner's answer when appropriate. Furthermore, if new arguments can now be addressed by the examiner by incorporating a new ground of rejection in the examiner's answer, the new arguments may be able to be addressed without reopening prosecution and thereby decreasing pendency.

It is envisioned that new grounds of rejection in examiner's answers would be rare, rather than a routine occurrence. The Office plans to issue instructions that will be incorporated into the MPEP requiring that any new ground of rejection made by an examiner in an answer must be personally approved by a Technology Center Director or designee and that any new ground of rejection made in an answer be prominently identified as such. It is the further intent of the Office to provide guidance to examiners that will also be incorporated into the MPEP as to what circumstances, e.g., responding to a new argument or new evidence submitted prior to appeal, would be appropriate for entry of a new ground of rejection in an examiner's answer rather than the reopening of prosecution. Where, for example, a new argument(s) or new evidence cannot be addressed by the examiner based on the information then of record, the examiner may need to reopen prosecution rather than apply a new ground of rejection in an examiner's answer to address the new argument(s) or new evidence.

Paragraph (b) of § 41.39 is added to set forth the responses an appellant may make when an examiner's answer sets forth a new ground of rejection. Appellant is required within two months from the date of the examiner's answer containing a new ground of rejection either:

(1) To request that prosecution be reopened by filing a reply under Rule 111 with or without amendment or submission of affidavits (Rules 130, 131 or 132) or other evidence, which would

preferably directed to individual claims. If appellant chooses to argue claims as a group as permitted, the Board will pick a single claim to decide the appeal to the group of claims as to that ground of rejection. If the prosecution and examination of a case has proceeded to the point of an appeal without applicant and the examiner discussing the merits of individual claims, that is an indication that the case is not ready for an appeal. If applicant believes that a rejection set forth in an Office action is "jumbled" or in any other manner does not clearly communicate the facts and reasons why the individual claims subject to the rejection are unpatentable, relief may be available by way of a petition under § 1.181.

The waiver provision of the proposed rule reflects the view expressed in *In re McDaniel* 63 USPQ2d 1462, 1468 (Fed. Cir. 2002) (Mayer, C.J. dissenting-in-part) that "in stating that claims 53-64 stand or fall together, [McDaniel] has waived any argument that claims 55-57 are patentable for reasons independent of claim 53."

Comment 56: One comment notes that each appeal is unique and that there "is no good reason for making detailed requirements as to the form of presentation of explanations and arguments in an appeal brief" as proposed in § 41.37(c)(1)(vii). The comment observes that the "Office properly assumes that an examiner is capable of responding to any appeal brief under either the existing rule or the proposed rule each of which simply requires a written statement in answer to appellant's brief including such explanation of the invention claimed and of the references and grounds of rejection as may be necessary. The comment asks the questions "Should not the same simple requirements be in effect as to the appeal brief? What's sauce for the goose should be sauce for the gander?"

Answer: The structure provided for by the requirements of § 41.37 ensures that Appeal Briefs will provide the information the Board needs to render an informed decision on the issues presented for review. While each appeal is unique in regard to the issues and arguments presented, there is certain information common to each appeal which is amenable to being provided by way of a prescribed format. The view expressed in the comment that examiners are under "simpler requirements in preparing an Examiner's Answer than appellant is in preparing the Appeal Brief" is misplaced. Detailed guidance to examiners as to procedural requirements in performing their duties

and preparing Office actions is typically contained in the MPEP, not the rules. The procedural requirements examiners must follow in preparing an Examiner's Answer are found in MPEP 1208.

Comment 57: One comment suggests that § 41.37(c)(1)(vii) be amended to add the word "separate" prior to "patentability" in the last sentence. The comment states that this would clarify that pointing out what a claim recites will not be considered an argument for "separate" patentability of a claim, since such an argument could in fact establish patentability of that claim without establishing "separate" patentability of the claim.

Answer: The suggestion to add the word "separate" prior to "patentability" in the last sentence has been adopted in § 41.37(c)(1)(vii) and § 41.67(c)(1)(vii).

Comment 58: One comment inquires if the requirement in § 41.37(c)(1)(ix) for an evidence appendix containing copies of any evidence submitted to the examiner and relied upon by the appellant in the appeal was inconsistent with the provision in § 41.7(b) that precludes a party from filing a paper previously filed in the same Board proceeding without Board authorization.

Answer: Section 41.7(b) has been amended so that the requirement in § 41.37(c)(1)(ix) for an evidence appendix containing copies of any evidence submitted to the examiner and relied upon by the appellant in the appeal is consistent with the provisions of § 41.7(b).

Comment 59: One comment suggests that § 41.37(c)(1)(ix) be amended to require identification of "when the evidence was submitted into the record by Applicants or where in the record that evidence was entered in the record by the Examiner." The comment states that this suggestion was made since examiners will frequently not make a positive statement indicating approval of entry into the record of evidence presented by applicants. The comment states that absent specific indication by the examiner that any evidence submitted was refused entry, the evidence is presumed to have been entered as of the submission date. Thus, the suggested change would remove any ambiguity regarding how to comply with this requirement should the examiner not make an affirmative entry of the evidence.

Answer: The suggestion is not adopted. Evidence submitted after final rejection is not presumed to have been entered and must be specifically admitted by the examiner as set forth in § 1.116 as amended by this rule making. Evidence submitted either before the

first Office action or after a non-final rejection may be presumed to have been entered only when treated by an examiner in an Office action. Accordingly, the requirement of § 41.37(c)(1)(ix) of a statement setting forth where in the record the evidence was entered in the record by the examiner is met by an explicit statement entering the evidence or implicitly by an Office action weighing the evidence. Prior to filing an appeal brief, if applicants have submitted evidence to the examiner and it is not clear if this evidence has been entered or not entered, appellants should contact the examiner to inquire as to the status of that evidence. For example, if a § 1.132 declaration is timely filed in response to non-final Office action and the next action by the examiner is a final rejection which does not mention the § 1.132 declaration, applicants should contact the examiner to inquire as to the status of the § 1.132 declaration before filing an appeal since a brief arguing that evidence is not permitted by § 41.37(c)(1)(ix). The likely result of such an inquiry would be a new Office action treating the § 1.132 declaration or being informed that the Office has no record of the § 1.132 declaration.

Comment 60: One comment requests clarification as to whether appendixes as required by §§ 41.37(c)(ix-x) are necessary at all when no evidence or related proceedings exist, or whether an appendix must be included with the indication "none."

Answer: Sections 41.37(c)(ix-x) require the appeal to contain an evidence appendix and a related proceedings appendix. If no evidence or related proceedings exist, an evidence appendix should be included with the indication "none" and a related proceedings appendix should be included with the indication "none." In addition, a brief containing a Table of Contents indicating that no evidence appendix is part of the brief or that no related proceedings appendix is part of the brief would be acceptable under the Rule since it would clearly indicate that no evidence is being relied upon by the appellant in the appeal or that no related proceedings having decisions rendered by a court or the Board exist.

Comment 61: One comment states that it would be useful to have an example of a format and content for an appeal brief that would comply with the new regulations published with the notice of final rule making and ultimately incorporated into the Manual of Patent Examining Procedure.

Answer: An example of a format and content for an appeal brief is a brief